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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,782	08/06/2001	Niels C. Holch	08339.0002-05000	7805

22852 7590 01/26/2005

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EXAMINER

HARRISON, JESSICA

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,782

Applicant(s)

HOLCH ET AL.

Examiner

Jessica J. Harrison

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-71, 73-93, 95-98, 100-102, 112-114 and 119-157 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-71, 73-93, 95-98, 100-102, 112-114 and 119-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/4/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a Continuing Examination of application serial No. 09/921,782 which was a continuation of prior application Ser. No. 08/877,375.

Applicant's amendment of August 6, 2004 is acknowledged. The specification has been further amended on page 2. Claims 1-52, 72, 94, 99, 103-111, and 115 -118 have been cancelled. Claims 53-71, 73-93, 95-98, 100-102, 112-114, and 119-157 are pending. Claims 67, 80, 84, 87, 92, 93, 98, 112, 113, 119, 120, 124, 129, 143, 145, 147, 150, 155 and 157 have been amended.

Specification

The amendments filed 8/30/2002 and 2/3/2003 are objected to under 35 U.S.C. 132 because each introduces new matter into the disclosure. **These objections are maintained and repeated hereinbelow.** 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In the amendment of 8/30/2003, the second paragraph remaining states " an interface to receive, ..., game information on a per-game basis, and *a processor for adjusting the player account balances on a per game basis*". As currently amended, the passage of contention reads "...an interface to receive, from the plurality of game terminals, player activity information on a per-game basis and *a processor for adjusting the player*

account balances on a per game basis". This language, previously delineated, still contains new matter.

The prior application, which matured into US Patent 6,280,328 states that both the game information (as defined herein) and the game results are sent to the account server after game play. Col8:18 – 26 and Fig5b step 542. While "after" each game is "per-game", per-game clearly encompasses during the game and prior to the game, possibilities that clearly are not encompassed by the prior disclosure. It is noted that the prior application disclosed an account validation prior to game play, as well as an account determination of sufficient funds. The prior disclosure does state the account balances in the terminal and central are monitored on a "per-game" basis (to detect fraud as early as possible) and that "activity information" is sent in "real time" and that "tracking of player activity on a per-game basis helps tailor player terminals". "Activity information" is separately defined from "game information". This, however, is not the same as adjusting the player account balances on a "per-game" basis. Furthermore, it is clear from a reading of the original disclosure that the processor updates account balances **after** each game. See Fig 5b, step 546, at least. Therefore, the specification as originally filed does not provide support for adjusting of account balances on a per-game basis.

As amended in the newly presented claims, applicant has now defined the player activity information, which as claimed is transmitted on a per-game basis, to include "game information". The original specification made it clear

that the game information was transmitted after each game. Furthermore, it is defined separately from the player activity information. Therefore, as presented the language is new matter.

Current amendment:

The present amendment now defines in the “means for transmitting player activity and game information to the central controller on a per game basis. As noted above, the specification is clear that the game information is only transmitted after play of a game and as such, the allegation that this information is transmitted on a per game basis is an enlargement of scope not previously set forth. Therefore, the amendment of August 6, 2004 also adds new matter to the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

Claims 80-86, 87-92, 98, 100-102, 112 – 114, 119 – 121, 143 – 146, 149, 150- 156 and 157 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite updating account information on a per-game basis. This language constitutes new matter as described hereinabove.

Claims 67-71, 80-86, 151-154, 87-97, 145-148, 150, and 155-157 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims as currently amended recite the game information being transmitted or received on a per-game basis or each time a wager amount is received. As outlined above, transmission of game information in the original disclosure only occurred after a game. Expansion of the definition to encompass prior to the game is new matter.

It is believed all instances of the types of new matter situations described above have been noted. However, due to the number of the claims, it is possible some offending claims have been inadvertently omitted. Applicant is thanked in advance for his cooperation in ensuring all claims presented are clear, concise and do not encompass new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3714

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 53 –71, 80-86, 151, 152, 87 – 93, 95-98, 100-102, 114, 119-123, 145-150, and 155-157 are rejected under 35 U.S.C. 102(b) as being anticipated by Hedges et al. (4,467,424). This rejection is maintained from the previous office action and repeated herein.

Applicant's amendatory language continues to be met by the rejections of record. Further clarification is provided herein below under response to argument heading.

Hedges discloses a remote gaming system which enables player's participation in selected wagering games from a remote terminal 10. The system includes a player terminal 10 which has at least touch input means, display means and ID/Account card reading means as well as software to execute the terminal functions and display. The system also includes a central controller 9 (called the credit station) and a croupier station where random numbers are generated. Given the number of claims presented, and that the claims differ only slightly in scope and variation of language, an exhaustive listing of each claim with respect to Hedges is not being made. The interpretations of Hedges in light of the claim language will be discussed while

limitations in the instant claims not discussed herein below are deemed to be readily apparent from a reading of Hedges. The claimed “means to transmit game information for each game” is taught at Hedges 13:11-12 and 13:36-37. The claimed “means for executing application program in response to an externally generated random number” is Hedges display processing application program, which executes in response to the random numbers generated at the croupier station (external) in order to display the game results to the player. This functions as a means for determining a game result as well. The claimed “means for adjusting the account after a game” is taught in Hedges at 13:61, 62 – the central updates the account after the game. Player identification is transmitted in the activation step taught in col 12 of Hedges. As for the claimed game information – Hedges transmits the game selection and the wager amount, at least. Hedges terminals do not use money. Hedges central credits upon game win, and debits upon game loss, after each game. Hedges encompasses a “terminal”, a “central”, a “system”, and as he is operated with a combination of hardware and software, Hedges includes “a computer-readable medium containing instructions for causing a computer to perform a method of operating gaming systems...” as claimed. Hedges is deemed to meet the claims as broadly claimed.

Claims 73 – 79, 124, 125, 127, 129, 130, 132, 134, 136, 138, 139, 141, 143 and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by Franchi (5,770,533).

This rejection is maintained from the previous office action and repeated herein.

Applicant's amendatory language continues to be met by the rejections of record. Further clarification is provided herein below under response to argument heading.

These claims share the feature of the transmission of game information to the central from the terminal after a game is played. Franchi includes a plurality of remote game terminals and a central computer. Game choices and amounts wagered are entered at player terminals. Game results are determined, displayed, and transmitted to the central which maintains player account balances additionally to those stored on the card. See 6:30- 36 and 7:30 – 45, at least. See also step 306 of Figure 3 where both balances are checked as a security feature. The reference is deemed to meet the claims as broadly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3714

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 126, 128, 131, 133, 135, 137, 140, and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi. This rejection is maintained from the previous office action and repeated herein.

Applicant's amendatory language continues to be met by the rejections of record. Further clarification is provided herein below under response to argument heading.

Franchi's random numbers used for game play appear to be generated internally of the terminal, or externally (use of Franchi with actual cards or table games) but not from the central or from a random number server. However, computer generation of random numbers is notoriously old and well known and capable of instant demonstration. Use of computerized RNG's in a gaming environment has been popularized in that it appears safer to some players who may think a dealer will cheat them. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Franchi with games utilizing computer generated random numbers, particularly generated centrally, so that players may perceive the game is fair.

Claims 120, 153 and 154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedges in view of Franchi.

Hedges fails to send the game information from the terminal to the central as recited in claim 120, and to check balances for security reasons as recited in claims 153, 154. Both of these are done in Franchi, in order to enhance security. It would have been obvious to one of ordinary skill in the art at the time of the invention to update the central after each game, to maintain duplicate balances and to compare balance calculations in Hedges as is done in Franchi, in order to provide a secure game system desirably taught by Franchi.

Response to Arguments

Applicant's arguments filed August 6, 2004 have been fully considered but they are not persuasive.

IDS:

With respect to the Information Disclosure Statement enclosed is a signed copy of applicant's PTOL 1449 dated 10/9/2003. The examiner has reviewed all PTO copies of parent and related files and is unable to located copies of the other documents not yet considered from applicant's IDS of 1/4/2002. Accordingly, as copies are unavailable to the examiner, the art has not been considered and has been lined out on the form. The examiner will consider copies of the lined through material should applicant present them in the future and view such as a completion of the prior IDS submission.

112 Objections/Rejections:

With respect to the Section 112 Rejections, applicant submits that because both player activity and game information on a per game basis are, in his opinion, clearly described in the original disclosure the Section 112 objections/rejections should be withdrawn. Applicant points to parent patent '328, col 8 lines 17 – 25 for support of game information being transmitted, and activity information transmitted at 8:52-56. The examiner remains unswayed.

Respectfully, the examiner's position outlined above regarding new matter has never been a question of "if" the information is transmitted or received, but an issue of "when" the respective information is transmitted and received. Simply because words exist in the disclosure does not entitle the context of the words to be overlooked. One must look at the disclosure as a whole, including context, and in continuing applications to the prosecution history, for the circumference of the invention when passing on the question of new matter. In the interview, applicant submitted for consideration the teaching of '328 at 5:24-27 of "Central controller network 104 tracks each player activity, preferably on a per game basis, to maintain current and comprehensive information about the players at any time during the players session at player terminals 100". Applicant has also pointed to the statement of "player terminals 100 transmit real-time to account server 400 all player activity information input by the player" ('328 8:53-54). Applicant seems to be submitting that "current and comprehensive" and "real time" are support for the use of "on a per game basis" or "each time a wager is received" for

transmission of game information or updating the account balance as now entered into the specification/claims. However, a broader view must be maintained.

In the specification, referenced for convenience via use of col:line of the '328 parent patent, applicant's position within context is untenable. At 2:8-10 "means for adjusting...according to the result of the games" indicates the adjustment must occur after the game as it is according to a result. At 2:28-30 "Finally, the central controller updates the participating player's account file according to the result of the games". Again, the language indicates the adjustment must occur after the game as it is according to a result. Further, at 8:17-21 "Win or loose, player terminal 100 sends the game result and game information to account server 400 (step 542[Fig 5])". The game must have occurred for the game result to be sent. The flow diagram of Fig 5 CLEARLY shows this to be the case. Col 8 lines 35-39 speak to the monitoring of the players account balance to reduce fraud as being on a per-game basis, but clearly is in the context of the information be sent "after" a game in that the balance is updated after a game and returned to a terminal for comparison. Thus, here use of 'per game' basis can only be read as "after a game".

Continuing, beginning at 8:52 the disclosure discusses real time monitoring and what it means to maintain current and comprehensive player activity data. This includes "information on the game played"[note past tense contextually indicating *after* a game], and "the credit or debit request for crediting or

debiting the players account" [contextually after a game played]. Further, guidance is provided as to applicants meaning of "current" or "real time", in context, in the next paragraph where it is disclosed that the report server generates reports for casino employees every two minutes. It is not seen how the statement of "current" or "real time" can support transmission of information/account on a per-game basis when in context it is defined as sufficiently accomplished ever two minutes. Finally, at 9:35-38 a reference is made to "central tracking of all player activity on a per game basis". In context this statement refers to what information is being stored long term for marketing reasons: that all the information for each game/player is maintained over time. This has no bearing on when information is transmitted to the central controller.

In further support of the examiner's position, the examiner notes context meaning of the terms of applicant's own words. As noted by the Supreme Court in *Festo Corb. V. Shoketsu Kinzoku Logyo Kabushiki Co.*, 535 U. S. 722, 122 S. Ct. 1831, 1828, 62 USPQ2d 1705, 1710 (2002), a clear and complete prosecution file record is important in that "[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process." In securing the parent patent overcoming prior art, including prior art also applied herein, applicant stated at no less than three times that the account was updated *after* a game. For example, on December 15, 1999 applicant stated

"Acres fails to disclose or suggest a player terminal transmitting game information after each game, or a central controller that receives the result after each game. Further Acres does not adjust the account information after each game. Any one of these elements distinguishes...In fact, Acres teaches away ...because floor controller 28 locally stores meter information which, at a 'certain time of day such as the end of the day or the drop period,' updates the meter information".

Here, patentability is asserted based upon data transmission after a game clearly distinguishing from at a predetermined time. On August 14, 2000 applicant opined

"Moreover, even if Hedges were modified as asserted by the Examiner, Hedges does not disclose or suggest 'transmitting player activity information after each game for which a wager amount was received from the participating player.'"

Finally, on January 30, 2001 applicant submitted

"the term 'after each game for which the wager amount was received from the participating player' means after each individual game."

Applicant may not have the meaning of the terms of the invention read one way for patentability in one application and then expand that meaning later in a continuation application. The prohibition of new matter serves public policy and the existence of continuation – in – part application practice provides appropriate recourse for applicants who continue improvements upon their inventions.

Given the above, it is felt the examiners position that the redefining of 'after each game' to read 'on a per-game basis' in that per-game encompasses

prior a game and during a game is clearly new matter and the position is appropriate.

Prior art rejections:

With respect to the anticipatory rejections based upon Hedges, Applicant submits that Hedges fails to teach every element of the claims and therefore must fail to anticipate. Applicant urges Hedges fails to disclose a means for displaying the result of the game. Applicant notes the examiner's interpretation of the reference with respect to the software and insists the reference then fails to teach a means for displaying the result of the game. Clearly applicant overlooks the CRT display which displays the result of the game and therefore meets the claimed structure and function. Both recited elements are taught in the Hedges reference.

Next, applicant argues Hedges fails to disclose a player terminal including means for determining the result of a game as recited in amended claim 60. The examiner interprets the game processing/display processing of the terminal which receives the data from the croupier station to meet this language. Presenting a display is a determination, at least to the specificity claimed.

With respect to Franchi, applicant submits Franchi fails to disclose a means for receiving a wager amount. Notwithstanding the fact that Franchi is directing to a gambling system and without the argued means would be

inoperative, Franchi clearly teaches a means for receiving a wager amount at 8:5-15. A 'betting amount' is, in the examiners opinion, a wager. Accordingly, Franchi continues to anticipate.

This argument serves as the basis for all arguments against the 103's based upon Franchi as well. The examiner has pointed out direct support for the means for receiving a wager amount in Franchi. Therefore, the 103 rejections, having not been otherwise challenged, stand as proper.

Conclusion

The examiner cannot offer any constructive help at this juncture as the examiner sees the direction of applicant's amendments and arguments to be in direction not supported by the original disclosure. Further, given this broader interpretation of the invention the prior art applied continues to bar patentability.

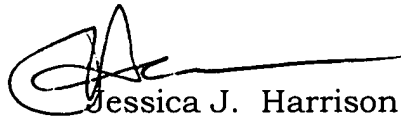
All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 571-272-4449. The examiner can normally be reached on M-F during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica J. Harrison
Primary Examiner
Art Unit 3714

jjh